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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/811,368

03/26/2004

Keith P. Thompson

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06/13/2008

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EXAMINER

MAI, HUY KIM

ART UNIT

PAPER NUMBER

2873

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/811,368	<b>Applicant(s)</b> THOMPSON ET AL.	
	<b>Examiner</b> Huy K. Mai	<b>Art Unit</b> 2873	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-135 is/are pending in the application.
- 4a) Of the above claim(s) 7-12 and 84-135 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 13-83 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 3/26/04 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/9/04</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election with traverse of Group I, claims 1-6 and 13-83 in the reply filed on Feb. 15, 2008 is acknowledged. The traversal is on the ground(s) that "Applicants note that MPEP § 803 requires that no such election or restriction be required, when the application can be searched and examined without undue burden on the Examiner. **In the present case, Groups I and IV, although not necessarily obvious in view of each other, are very similar in subject matter** (emphasized added). More specifically, the correlated parameters of Group I may be obtained using statistical analysis as supported in paragraphs 108, 128, 132, and 172 of the specification. For this reason, Applicants respectfully submit that the inventions described in these claims are not "independent" as defined in MPEP § 803 and that the restriction requirement therefore is improper as between Groups I and IV. In such a situation, it would not be overly burdensome on the Examiner to check for both of these alleged "separate" inventions at the same time". This is not found persuasive because it is not clear, based on what the applicant indicates that "the application can be searched and examined without undue burden on the examiner". In fact, the Group I, itself, includes 7 different independent claims, each of these independent claims is treated as a different invention i.e. they have different scope of the inventions. The requirement in the previous action is not based on the different scope of the invention, but the Groups I-V are directed to related inventions. They are distinct each from other for the reasons provided in the previous action such as:

(1) the inventions as claimed are **either not capable of use together or can have a materially different design, mode of operation, function, or effect** (emphasized added);

(2) the inventions **do not overlap in scope, i.e., are mutually exclusive** (emphasized added); and

(3) the inventions as claimed are **not obvious variants** (emphasized added). See MPEP § 806.05(j). In the instant case, **the inventions as claimed are different modes of operation, different functions and different effects** (emphasized added). Furthermore, the inventions as claimed do not encompass overlapping subject matter and there is **nothing of record to show them to be obvious variants** (emphasized added).

The applicant, in traverse the requirement, does not analyze whether the groups I and IV have the same materially design, mode of operation, function, or effect. The applicant does not analyze whether the groups I and IV have overlap in scope. Further, the applicant does not analyze whether the groups I and IV are obvious variants.

Simply state “In the present case, Groups I and IV, although not necessarily obvious in view of each other, are very similar in subject matter” is not an evidence to support for the traversal. The applicant points out “the correlated parameters of Group I may be obtained using statistical analysis as supported in paragraphs [108], [128], [132], and [172] of the specification”. These paragraphs neither discuss the storing means and the statistically analyzing means of neuro-ocular wavefront data” as claimed in Group IV, nor compare the correlating means as claimed in Group I and the storing means and the statistically analyzing means as claimed in Group IV.

The requirement is still deemed proper and is therefore made FINAL.

Accordingly, claims 1-6 and 13-83 will be examined in this action as bellows.

Claims 7-12 and 84-135 are withdrawn from consideration as directed to non-elected inventions under 37 CFR 1.142(b).

***Information Disclosure Statement***

2. The information disclosure statement (IDS) filed Aug. 9, 2004 is acknowledged.

***Claim Objections***

3. Claims 28-31 are objected to because of the following informalities: It appears that claim 28 depends from claim 17; otherwise, claims 28-31 are improper dependent form for failing to further the subject matter of a computer-readable medium of claims 15 and 16. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-6, 13-83 are rejected under 35 U.S.C. 102(e) as being anticipated by Dai et al (US 2008/0106698).

Regarding claims 13-14 and 50-73, Dai et al, Figs. 3, 9C-13, 18C-24, discloses a device for establishing an optical surface shape (or presbyopia correction) that mitigates or treats presbyopia in a particular patient wherein the combination of distance vision and the near vision in a patient can be improved, often based on input patient parameter. The device including a module and/or an optimizer for establishing the presbyopia correction via a Goal function or a function of modulation transfer function (MTF) or Zernike polynomials. The MTF is expressed in term of an equation including coefficients  $\alpha_1$ ,  $\alpha_2$ ,  $\alpha_3$ ... (see page 6, [0083]). The Zernike

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polynomials is expressed in term of an equation including coefficients a, b, c, d, e, and f (see page 8 [0097]). These coefficients in combine with the input patient parameters are nothing more than correlating means as the applicant claimed. Establish an optical surface shape is nothing more than “obtain neuro-ocular wavefront data” as the applicant claimed. Further Dai et al (page 5, [0070]) discloses that “the present invention will often take advantage of the fact that the eye changes in viewing distance”. It is clear that obtain the neuro-ocular wavefront data via MTF in combine with the interactivity of patient via “the fact that the eye changes in viewing distance”. In another word, Dai et al discloses interactively obtaining means.

Regarding claims 13, 59, since the optical surface shape is calculated from the coefficients in combine with the input patient parameters, the Dai et al programmable device including means for calculating the correction factors for treating the patient.

Regarding claims 60-63, Dai et al ([0023], [0093]) discloses the correction factors is used to treat the patient with a contact lens, a spectacle lens or a tissue ablation profile for refractive surgery. The refractive surgical techniques such as RK, AK, ALK... are intended used.

Regarding the method claims 1-6 and 17-49, it should be noted that although claims 1-6 and 17-49 “method claims”, the method steps consist of the broad steps of “obtaining” and “correlating” etc and therefore these steps would be inherently satisfied by the apparatus of the Dai et al reference.

Regarding claims 15 -16 and 74-73, since Dai et al’s invention including a module and/or optimizer and/or a programmable device wherein the programmable device for obtaining neuron-ocular data and correlating the neuron-ocular to the patient parameter. The programmable device including instruction in establishing the presbyopia correction. The programmable device

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inherently includes computer-readable code medium for optimizing the presbyopia correction. Thus the Dai et al's computer-readable code medium including computer-readable code adapted to instruct a programmable device to interactively obtain neuro-ocular wavefront data from a subject, and computer-readable code adapted to instruct a programmable device to correlate the neuro-ocular wavefront data to parameters associated with the visual system of the subject.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huy Mai whose telephone number is (571) 272-2334. The examiner can normally be reached on M-F (8:00 a.m.-4:30 p.m.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky L. Mack can be reached on (571) 272-2333. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1562.

/Huy Mai/  
Huy Mai  
Primary Examiner, Art Unit 2873

HKM  
June 13, 2008